



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,833	01/27/2004	Michal Ayalon-Soffer	27256	8418
7590 Martin D. Moynihan PRTSI, Inc. P. O. Box 16446 Arlington, VA 22215		03/22/2007	EXAMINER WHALEY, PABLO S	
			ART UNIT 1631	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/764,833

Applicant(s)

MICHAL AYALON-SOFFER

Examiner

Pablo Whaley

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-209 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 9-13 and 15-209 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/10/2007.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *CLAIMS UNDER EXAMINATION*

Applicants' response, filed 12/26/2006, has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied, as necessitated by amendment. They constitute the complete set presently being applied to the instant application. Claims herein under examination are claim 14, as it reads on the elected SEQ ID No: 1. Claim 8 has been canceled. This application contains claims 1-7, 9-13, and 15-209 drawn to an invention nonelected with traverse in the response filed 05/31/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *INFORMATION DISCLOSURE STATEMENT*

The information disclosure statement filed 01/10/2007 has been considered in part. The Knudson et al. reference does not contain a publication data and therefore has not been considered.

### *INFORMALITIES*

The amendments to the specification and claim 1, which now recite "term inactivating" the hyperlinks, are not acceptable as the hyperlinks are now simply "inactive" hyperlinks since they are still in hyperlink format. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code on page 2, 3, and elsewhere. See MPEP § 608.01(b).

**CLAIM REJECTIONS - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well-established utility.

Applicant's arguments, filed on 12/26/2006, that the specific structure of the claimed Met variant has an asserted utility [Specification, p. 80] that relates to SEQ ID NO: 1 and 3 is not persuasive for the following reasons.

As set forth in the previous office action, the specification discloses a utility for novel soluble polypeptides and polynucleotides encoding the polypeptides in the diagnosis and treatment of a wide range of diseases [Specification, p. 23 and 26]. However, this utility is generic to the class of Met polypeptides and these limitations are not specific to claim 14. Therefore, the disclosed utility is not specific to the claimed sequence. Other well-established utilities have been disclosed in the Specification (e.g. Met splice variants that can serve as an inhibitor of Met-HGF interaction [p.80 and 81], however they are also not specific to the claimed sequence.

Applicant is reminded that a "specific utility" is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." *In re Fisher*, 421 F.3d 1365, 1371, 76 USPQ2d 1225, 1230 (Fed. Cir. 2005). This contrasts with a general utility that would be applicable to the broad class of the invention. For example, indicating that a compound may

Art Unit: 1631

be useful in treating unspecified disorders, or that the compound has "useful biological" properties, is not sufficient to define a specific utility for the compound. See, e.g., *In re Kirk*, 376 F.2d 936, 153 USPQ 48 (CCPA1967); *In re Joly*, 376 F.2d 906, 153 USPQ 45 (CCPA 1967). Similarly, a claim to a polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker" would not be considered to be specific in the absence of a disclosure of a specific DNA target. See *In re Fisher*, 421 F.3d at 1374, 76 USPQ2d at 1232. This rejection is therefore maintained.

Claim 14 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a well asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. This rejection is therefore maintained.

## CONCLUSION

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1631


will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Whaley whose telephone number is (571)272-4425. The examiner can normally be reached on 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pablo S. Whaley  
Patent Examiner  
Art Unit 1631  
Office: 571-272-4425  
Direct Fax: 571-273-4425

  
**REMY YUCEL, PH.D., J.D.**  
**SUPERVISORY PATENT EXAMINER**